



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,907	03/22/2004	Michael I. Rosenfelt	53086-00703USPT	2039

24238 7590 11/18/2005

JENKENS & GILCHRIST
1401 MCKINNEY
SUITE 2600
HOUSTON, TX 77010

EXAMINER

IWUCHUKWU, EMEKA DERRICK

ART UNIT	PAPER NUMBER
----------	--------------

2645

DATE MAILED: 11/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/805,907		ROSENFELT ET AL.	
	Examiner		Art Unit	
	Emeka D. Iwuchukwu		2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:
It does not identify the citizenship of each inventor.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-10,19,20,25-48,43&44 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Publication 2004/0153713 A1 to Aboel-Nil et al. (*hereinafter Aboel-Nil*).

With respect to claims 1&25, Aboel-Nil teaches the method and system for providing backup electronic messaging services to wireless devices during outages, comprising: a wireless device (paragraph 27), sending email messages from a primary email system to a user's wireless device (paragraph 22); when said primary email system is unavailable, redirecting said email messages from said primary email system to a secondary email system and from said secondary email system to said user's wireless device (paragraphs 22,26); notifying said user that said email messages are available on said user's wireless device through said secondary email system at

Art Unit: 2645

such time as said redirection of said email messages has been implemented (paragraphs 22,27); at such time as said primary email system becomes unavailable, the user of said wireless device is notified that said primary email system is unavailable (paragraph 15); at such time as said primary email service becomes available, redirecting said email messages from said secondary email system to said primary email system and from said primary email system to said user's wireless device (paragraphs 22,29,31); notifying said user that said email messages are available on said user's wireless device through said primary email system at such time as said redirection of said email messages has been implemented (paragraphs 22,29); and synchronizing said email messages received on said secondary email system while said primary email system was unavailable with the messages in said primary email system (paragraphs 22,30).

With respect to claims 2&26, Aboel-Nil teaches the method and system of claims 1&25, wherein said primary email system is located remotely from said secondary email system and is interconnected to said secondary email system through the Internet (paragraph 24).

With respect to claims 3&27, Aboel-Nil teaches the method and system of claims 1&25, wherein the determination of when said primary email system is unavailable is performed manually by assessing whether an error message has been received indicating an inability to deliver an email message to said primary email system (paragraph 25).

With respect to claims 4,5,28&29, Aboel-Nil teaches the method and system of claims 1&25, wherein said email messages to all email addresses on said primary email system are automatically redirected to said secondary email system at any time any (paragraph 26), and after some, but less than all (paragraph 26), of said email messages on said primary system are unavailable.

With respect to claims 6&30, Aboel-Nil teaches the method and system of claims 1&25, wherein said step of notifying said user that said email messages are available on said secondary email system further includes the automated delivery of a preexisting notification email message to an alternate email address for said users (paragraph 27).

With respect to claims 7&31, Aboel-Nil teaches the method and system of claims 1&25, wherein assessing the time at which said primary email system is available includes periodically pinging email addresses on said primary email system and evaluating whether a response is received from said email addresses (paragraph 28).

With respect to claims 8&32, Aboel-Nil teaches the method and system of claims 1&25, wherein said notification of said user that said email messages are again available on said primary email system consists of the automated delivery of a preexisting notification email message to an alternate email address for said user (paragraph 29).

With respect to claims 9&33, Aboel-Nil teaches the method and system of claims 1&25, wherein the ability to redirect said email messages from said primary email system to said secondary email system is password protected (paragraph 26).

With respect to claims 10&34, Aboel-Nil teaches the method and system of claims 1&25, wherein one or more of said wireless devices is selected from the group consisting of personal digital assistant devices, cell phones and pagers (paragraph 27).

With respect to claims 19,20,43&44, Aboel-Nil teaches the method and system for delivering backup messages to wireless devices, comprising: maintaining a mapping of alternate email addresses of wireless devices, wherein said wireless devices has multiple modes of receiving data; upon an outage of the primary path for delivering email messages to said wireless

Art Unit: 2645

device, forwarding said email messages to said wireless device through said alternate mode or email address (paragraphs 22,27,29).

4. **Claims 11,16,35&40** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,857,009 to Ferreria et al. (*hereinafter Ferreria*).

Ferreria teaches the method and system of intercepting and redirecting email messages to wireless devices during an outage of the primary email system, comprising: during an outage of the company's primary email system (Col 20 Lines 25-28), intercepting email messages prior to such time as said email messages pass through the company's firewall and redirecting said email messages to a pre-specified alternate location (Col 20 Lines 14-15,38-48) and intercepting messages intended for a primary email system within an email application through the use of an event sink desired to inspect email message traffic and redirect or copy said email messages to an alternate location (Col 19 Lines 15-24; Col 20 Lines 9-17).

5. **Claims 12,14,36&38** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Publication 2005/0009502 A1 to Little et al. (*hereinafter Little*).

Little teaches the method and system for intercepting and redirecting email messages to wireless devices during an outage of primary email system, comprising: during an outage of the company's primary email system, intercepting email messages intended for a primary email system after said email messages pass through said company's firewall, but before said email messages enter said primary email system, and redirecting said email messages to a pre-specified alternate location (paragraph 35), and after said email messages enter said primary email system, but before said email messages leave the Internet mail connector and redirecting said email messages to a pre-specified alternate location (paragraph 35).

Art Unit: 2645

6. Claims 18,21-24,32&45-48 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,557,036 to Kavacheri et al. (*hereinafter Kavacheri*).

With respect to claims 18&32, Kavacheri teaches the method and system for intercepting and redirecting email messages to wireless devices during an outage of the primary email system, comprising: during an outage of the company's primary email system (Col 5 Lines 18-27), changing the domain name system designation of said primary email system so that inbound email messages are directed to an alternate facility (Col 2 Lines 63-37; Col 6 Lines 8-16; Col 8 Lines 28-39).

With respect to claims 21&45, Kavacheri teaches the method and system for delivering backup messages to wireless devices, comprising: pulling messages from a mailbox within a secondary email system to a wireless device (Col 8 Lines 4-14).

With respect to claims 22,23,46&47, Kavacheri teaches the method and system of claims 21&45, wherein said mailbox is a pop3 and an imap4 mailbox.

With respect to claims 24&48, Kavacheri teaches the method and system for acquiring information necessary for providing backup email messages to wireless devices, comprising: acquiring information from a primary email system and a primary wireless gateway, wherein said information is select from the group consisting of wireless device users, email addresses, device identification information, encryption keys, user preferences and user's wireless platform; and at such time as said primary email is unavailable (Col 5 Lines 18-27; Col 6 Lines 8-16), providing said information to the device receiving the inbound SMTP stream during said unavailability so that email messages can be redirected to the proper email addresses (Col 7 Lines 5-13).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. **Claim 13&37** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication 2005/0009502 A1 to Little et al. (*hereinafter Little*) in view of U.S. Patent Publication 2005/0120229 A1 to Lahti.

Little teaches the method and system of claims 12&36. Little fails to expressly disclose that the method and system operate integrally with the company's anti-virus or anti-spam application.

In the same field of endeavor, Lahti teaches a similar method and system, wherein said method and system operate integrally with the company's anti-virus or anti-spam application.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the system and method operate integrally with the company's anti-virus or anti-spam application so the firewall incorporated into the web servers can be used to

Art Unit: 2645

authenticate and authorize the HTTP connections, and to prevent unauthorized access to the anti-virus applications as taught by Lahti (paragraph 30).

10. **Claims 15&39** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent Publication 2005/0102074 A1 to Kolls in view of U.S. Patent No. 6,957,248 to Quine et al. (*hereinafter Quine*).

Kolls teaches the method and system for intercepting and redirecting email messages to wireless devices during an outage of the primary email system, comprising: during an outage of a company's primary email system, intercepting email messages within a primary email system on a real-time basis and redirecting said email messages to an alternate location (paragraph 393). Kolls fails to specifically mention the email messages are directed to non-functioning addresses.

In the same field of endeavor, Quine teaches a similar method and system wherein the email messages are directed to non-functioning addresses (Col 10 Lines 23-42).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the method or system for non-functioning addresses for dynamic email forwarding as taught by Quine (Col 10 Lines 23-42).

11. **Claims 17&41** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 6,557,036 to Kavacheri et al. (*hereinafter Kavacheri*) in view of U.S. Patent Publication 2004/0235503 A1 to Koponen et al. (*hereinafter Koponen*).

Kavacheri teaches the method and system for intercepting and redirecting email messages to wireless devices during an outage of the primary email system, comprising during an outage of the company's primary email system, redirecting email messages intended to be delivered to

Art Unit: 2645

said primary email system to an SMTP host. Kavacheri fails to expressly disclose the host has a lower priority designation.

In the same field of endeavor, Koponen teaches a similar method and system that redirects email messages intended to be delivered to said primary email system to an SMTP host with a lower priority designation (paragraphs 22,32).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to redirect email messages with a lower priority designation so as to save space on the primary email system's storage device.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emeka D. Iwuchukwu whose telephone number is (571) 272-5512. The examiner can normally be reached on M-F (9.30AM - 6PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**OVIDIO ESCALANTE
PATENT EXAMINER**

EDI

Ovidio Escalante